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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/584,638	05/31/2000	Marcos N. Novaes	POU9-2000-0010-US1	4280

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EXAMINER	
WON, MICHAEL YOUNG	

ART UNIT	PAPER NUMBER
2155	

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No.	Applicant(s)	
	09/584,638	NOVAES ET AL.	
	Examin r	Art Unit	
	Michael Y Won	2155	

--The MAILING DATE of this communication appears on th cover sheet with the correspondence address --

THE REPLY FILED 06 January 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☐ The period for reply expires _____months from the mailing date of the final rejection.

b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
   (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ they raise the issue of new matter (see Note below);
   (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.
   NOTE: _____.
3. ☒ Applicant's reply has overcome the following rejection(s): 35 U.S.C. 112, 1st paragraph.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a)☐ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *see attached document*.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a)☐ will not be entered or b)☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: *8-11,22,30-33,44,56-59 and 70*.

   Claim(s) objected to: _____.

   Claim(s) rejected: *1,4-7,12-21,23-29,34-43,45-55,60-69,71 and 72*.

   Claim(s) withdrawn from consideration: _____.
8. ☐ The drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

DETAILED ACTION

1. This advisory action is in response to the after final amendment ("Response to Final Office Action") filed January 6, 2005.

Drawings

2. The objection to the drawings under 37 CFR 1.83(a) has been withdrawn based on the arguments presented in the after final amendment.

Claim Rejections - 35 USC § 112

3. Prior rejection of claims 1, 18, 25, 40, 47, 48, 51 and 66 under 35 U.S.C. 112, first paragraph, has been withdrawn based on the arguments presented in the after final amendment.

Response to Arguments

4. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "processing") are not recited in the rejected claim 1. Although the claims are interpreted in light of the specification, limitations from the specification are not read into

the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Furthermore, *Christensen* clearly teaches of processing (see col.7, lines 15-17).

5. In response to applicant's argument that *Christensen* does not teach "creating an ordered list of service addresses to be used by a client node of a computing environment to reach a service of a computing environment, the examiner argues that *Christensen* clearly teaches of a list of addresses used by said client node (see col.2, lines 29-33: "returns all of the mapped (proxy) associated network addresses to the client"; and col.4, lines 36-39: "provide the clients 120 with the network (e.g., IP) address(es) of requested services in response"). Furthermore, it would be implicit that when more than one address is provided to the client, such address would be ordered consistent the fact that *Christensen* teaches of an ordered list of addresses (see col.24, lines 14-15) coupled with the fact that *Christensen's* objective is to increase the availability (see col.2, lines 53-57 and col.22, lines 45-49). Therefore, the list of addresses would be implicitly ordered to teach the most optimal address.

6. In response to applicant's argument that *Freund* does not teach the limitation "list is ordered specifically for said client node based on one or more characteristics of said client node", examiner agrees that *Freund* proposes creating access rules, but Freund also teaches that the access rules can specify criteria such as "list of URLs (or WAN addresses) that a user application can or (cannot access)" (see abstract). Furthermore, *Freund* teaches that by "intercepting process loading and unloading and keeping a list of currently-active processes, each client process", not the client itself or the user, "can be checked for various characteristics...". Clearly, *Freund* teaches the recited element

of the claimed invention. Additionally, the "ordering" of the address does not need to be taught by *Freund* since *Christensen* implies it.

7. The applicant is reminded that during examination the claims are given their broadest reasonable interpretation consistent with the specification. Clearly, the teachings of *Freund* and *Christensen* to one of ordinary skill in the art are within the scope of the invention and therefore applicable in the rejection.

8. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, although *Christensen* teaches of a basic system, *Freund* teaches of a more realistic approach wherein the Internet is comprised of not only increasing accessibility but also restricting accessibility. Therefore, it would have been obvious to one of ordinary skill in the art to employ both in a realistic World Wide Web.

9. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does

not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

10. Based on the above responses, the dependent claims rejected in the previous office action remain rejected.

HOSAIN ALAM
SUPERVISORY PATENT EXAMINER